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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,941	04/05/2004	Nicholas Healey	P67148US1	2300

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WASHINGTON, DC 20004

EXAMINER
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DINH, DUC Q

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/816,941

Applicant(s)

HEALEY, NICHOLAS

Examiner

DUC Q DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 32-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 32-35 recites the limitation "means for restricting travel of the control member in said plane (claim 32-34) or mean for preventing movement of the control member in the x-y plane".

Although the specification does mention "the control member is acted upon by two or more spaced-apart fingertips of a user, and travel of the control member is restricted in a predetermined plane (page 3, lines 13-15 page 4, lines 11-14). There is no support for the "means for restricting the travel" or "means for preventing the movement of the control member in the x-y plane.

The examiner examines the application based on the best understood of the claimed language.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32-35 recites the limitation "said plane" in line 2. There is insufficient antecedent basis for this limitation in the claim.

*Drawings*

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for restricting travel of the control member or means for preventing the movement of the control member in the X\_Y plane the must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21-23, 25, 35-37-38, 41-42, 46 and 50-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoggarth (U. S. Patent No. 6,654,044).

In reference to claim 21, Hoggarth discloses in Fig. 4 comprising: a post 50 (corresponding to the fixed mounting), which the lower end is rigidly secured to force transducer indicated by arrows X and Y (corresponding to the transducer means), body 62 (corresponding to the control member) connected at with the post 50 at electrical contacts within the post, the movement of the force transducer is translated into signals representing movement in the Y and X directions as indicated in the Fig. 4 (col. 4, lines 7-60).

In reference to claims 22 and 23, Hoggarth discloses the control surfaces 64 and 80 of the control member 60 as claimed.

In reference to claims 25 and 35, Fig. 4 shows the control member is disposed in the cavity of the post 50 and the cavity having inner surface and control member 60 having outer surface facing the inner surface of the of the cavity and preventing the control member in the X and Y plane as claimed.

In reference to claim 36, Hoggarth discloses as the joystick is progressively rotated in several degrees of freedom, associated angular torques are generously and equiangularly resisted by the entire keyboard footprint due to the central location within the keyboard of the joystick mounting site (col. 3, lines 26-32).

In reference to claim 37, Hoggarth shows the keyboard in Fig. 1.

In reference to claim 38, Hoggarth discloses the control circuitry 12 in Fig. 4 as claimed.

In reference to claim 41, 52-54, Hoggarth discloses two switches 64 and 80 in the control member and grip-able as claimed.

In reference to claim 42, Hoggarth discloses the transducer as arrows X and Y in Fig. 4.

In reference to claims 46 and 50-51, refer to the rejection as applied to claim 1.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 29-35, 45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoggarth.

In reference to claims 29 and 47, Hoggarth does not disclose the oval shape for the control member. However, it would been obvious to one of ordinary skill in the art to change the shape of the control member as desired as was judicially recognized with IN RE DAILEY, 149

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USPQ 147 (CAPA 1976) which recognizes that change the form and shape well known element is normally not desired toward patentable subject matter.

In reference to claims 30-31, 45 and 48 Hoggarth does not discloses the dimension of the control member as claimed; however, it would been obvious to one of ordinary skill in the art to change the dimension of the control member as desired as was judicially recognized with IN Rose 105 USPQ 237,(CCPA 1955), which recognizes that change the size and shape well known element is normally not desired toward patentable subject matter.

In reference to claims 32-35, Fig. 4 shows the control member 60 is attached to the cavity of the post 50 (corresponding to the restricting member). However, Hoggarth does not discloses that the restricting member in at least 50mm or less or 30mm or less or 10 mm or less. It would have been obvious for one of ordinary skill in the art at the time of the invention was made to restrict the control member as user choice for controlling the cursor when the control member is used as a Track Point device which located in between the key of the keyboard as discloses in Fig. 2.

10. Claims 26, 39-40, 43, 44 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoggarth in view of Klein et al. (U. S. Patent No. 6,205,021).

In reference to claim 39-40, 43, Hoggarth discloses everything except the pointing device located in the wrist rest area of the laptop computer. Klein et al. discloses pointing device is located in the wrist rest surface of the laptop computer as claimed.

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It would have been obvious for one of ordinary skill in the art at the time of the invention was made to learn the teaching of Klein et al. i.e.: providing the pointing device in the wrist rest surface so that it would not interfere with the alphanumeric key when the user using the keyboard for entering text.

In reference to claim 44, Hoggarth discloses two switches 64 and 80 in the control member as claimed.

In reference to claim 26 and 49, Fig. 1 of Klein et al. shows the pointing device having a wrist rest surface as claimed.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DUC Q DINH** whose telephone number is **(703) 306-5412**. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **RICHARD A HJERPE** can be reached on **(703) 305-4709**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivery response should be brought to: Crystal Park II, 2121 Crystal Drive,  
Arlington, Va Sixth Floor (Receptionist)



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

DUC Q DINH

Examiner

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DQD

September 16, 2004

  
REGINA LIANG  
PRIMARY EXAMINER